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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/558,741 04/26/00 HUSTON

J PF0926.105

EXAMINER

HM12/0327

CHIRON CORPORATION
INTELLECTUAL PROPERTY R440
PO BOX 8097
EMERYVILLE CA 94662-8097

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/558,741

Applicant(s)

Huston et al.

Examiner

Alana M. Harris, Ph. D.

Group Art Unit

1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 33, 42, 43, and 50-96 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 33, 42, 43, and 50-96 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

x Restriction Election Facsimile Transmission

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 33, drawn to an isolated polypeptide, classified in class 530, subclass 350.
Claim 33 will be examined with Group I to the extent that the polypeptide is SEQ ID NO:2.
 - II. Claim 33, drawn to an isolated polypeptide, classified in class 530, subclass 350.
Claim 33 will be examined with Group I to the extent that the polypeptide is SEQ ID NO:6.
 - III. Claims 42, 43 and 50-63, 71-73, 77-79, 83-85, drawn to an isolated DNA molecule encoding SEQ ID NO:6, classified in class 536, subclass 23.1.
 - IV. Claims 34-70, 74-76, 80-82, 86-96, drawn to an isolated DNA molecule encoding SEQ ID NO:2, classified in class 536, subclass 23.1.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-IV are structurally and functionally different products. The first two Groups, I and II differ from Groups III and IV because both sets of groups are made by different methods and have different uses. Further, the polypeptides of Groups I and II are composed of different amino acids resulting in two distinct proteins. And the polynucleotides of Groups III and IV encode two different polypeptides. The examination of all groups would require different

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searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Attempts to reach Roberta Robins by telephone on March 19, 2001 to request an oral election to the above restriction requirement were unsuccessful. Ms. Robins left a telephonic message for the Examiner requesting restriction/election requirement in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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6. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at Anthony.Caputa@uspto.gov or 703-308-3995. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
7. Papers related to this application may be submitted to Group 1642 by facsimile transmission. Papers should be faxed to Group 1642 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242 or (703) 305-3014.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 3:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703)308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.

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ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000